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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,922	04/21/2004	Bernhard Riepler	RIEPLER-4	5644

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COLLARD & ROE, P.C.
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Roslyn, NY 11576

EXAMINER

BOTTORFF, CHRISTOPHER

ART UNIT PAPER NUMBER

3618

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/828,922	RIEPLER, BERNHARD	
	Examiner	Art Unit	
	Christopher Bottorff	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 2-38, 40 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species X, directed to the runner device disclosed in relation to Figures 13 and 14, in the reply filed on February 27, 2006 is acknowledged. The traversal is on the grounds that the species disclosed in relation to Figures 13 and 14 is not a patentably distinct species. This is not found persuasive because no evidence of record demonstrates that the species is an obvious variant of the other species, and the structural characteristics of the elected species are unique from the structural characteristics of the other species such that the elected species is patentably distinct.

As stated in the restriction requirement, "Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention."

Applicant asserts that only two patentably distinct species have been disclosed. The first is a climbing aid at the running surface of the runner device and the second is a means for enhancing the slipping and friction resistance at the top surface of the device. The disclosure presents multiple variants of each of these two general concepts.

However, the contention that the variant, or species, depicted in Figures 13 and 14 is not patentably distinct from the other variants is not supported by evidence that the variant depicted in Figures 13 and 14 is an obvious variant. Moreover, Applicant has not admitted clearly on the record that the elected species is an obvious variant of the general concept. In contrast to Applicants contention, the disclosure presents significant structural differences between the variants. These differences would render each variant as being patentably distinct from the other variants. Examination is limited to one patentably distinct variant of one patentably distinct general concept.

The restriction requirement is still deemed proper and is therefore made FINAL.

In the event that a claim generic to all or a group of variants is allowed, all applicable variants defined in the dependent claims will be rejoined.

Claims 1-41 are pending. Claims 2-38, 40, and 41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Applicant asserts that claims 1, 6-14, 17-26, 32, 33, and 35-40 read on elected species X. However, a careful review of the claims has revealed that only claims 1 and 39 read on elected species X. Claim 6 requires an orifice, which is not present in the elected species. Claim 7 requires a housing compartment that is disposed between the top layer and the running layer, which is not present in the elected species. Claims 8-14, 18, 23-25, 35-38, and 40 depend claim 7 and also define the housing compartment of the non-elected species. Claim 17 requires the device to be disposed in a binding mounting region, which is not required in the elected species. Claims 19 and 26

Art Unit: 3618

depend from claim 3, which Applicant recognizes as not reading on the elected species. Claim 20 requires a grid-type-arrangement, which is not present in the elected species. Claim 21 requires webs, which is not present in the elected species. Claim 22 requires the top or running layer to be mounted so as to be at least slightly displaceable in the direction toward the interior, which is not present in the elected species. Claim 32 depends from claim 4, which Applicant recognizes as not reading on the elected species. Also, claim 33 requires a cambered top or running layer that is elastically flexible, which is not present in the elected species. Accordingly, claims 1 and 39 have been considered.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on April 21, 2004 was considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "consisting of" in line 1, which suggests that the claimed device has each of the components that are listed in the claim. Claim 1 also recites "optionally" in line 2, which suggests that the edging elements may not be present in the device. The claim is not clear as to how a component may be optional in a device that consists of that component. For the purposes of examination, the expression "consisting of" has been interpreted as "comprising" such that the edging elements may be optional.

Claim 1 also recites the expression "and/or" on lines 4 and 6. The expression is not clear as to whether the claim requires a top surface and the running surface to have the recess, or if only one of the top and running surface must have the recess. For the purposes of examination, "and/or" has been interpreted such that the top *or* running surface may have the recess.

Claim 39 recites the expressions "in particular" and "for example, in particular" in lines 2, 3, and 4. These expressions are indefinite in that they do not clearly limit the claim to the specific structures of an indentation, a surface inset, and a glued joint. For the purposes of examination, claim 39 has been interpreted to broadly define the recited groove, insert piece, and adhesive bond without narrowly defining the structure by an indentation, a surface inset, or a glued joint.

Art Unit: 3618

Claim 39 recites the limitations "the insert piece" and "the surface inset" in line 3.

There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Stewart US 5,797,779.

Stewart discloses a board-type runner device 14 comprising a top layer 32 with a top surface and a running layer 50 with a running surface lying opposite the top layer 32. See Figure 10. The top surface of the top layer 32 has a recess that accommodates a device 34 in the region of the recess for increasing slipping and friction resistance at the top surface. See Figure 10 and column 4, lines 65-67.

The recess is provided in the form of a groove in the top layer 32 along the perimeter of layer 32. See Figure 10. The device 34 is in the form of an insert piece that is affixed to the groove surfaces at a surface region by means of an adhesive bond. See Figure 10 and column 6, lines 42-47.

Art Unit: 3618

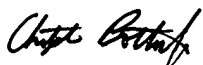
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hagen, Poppen, McDonald et al., Nidecker, Urbain, Hardy, Tiltola, Muse, Jr., Arnsteiner, Snyder, Fischer, Oakland, Brown, III, Nealy, Bejean et al., Rouser et al., Simonson, Jodelet, Krafft et al., Piegay, Sutherland, and Gousie disclose board-type runner devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (571) 272-6692. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher Bottorff